REMARKS

I. Claim Status

Claims 37, 40, 41, 43-51, 104 and 105 are pending in this application. With this response, claims 37, 40, 41, 43-51, 104 and 105 are canceled; and claims 106-122 are added.

Claim 106 recites the use of both a fatty alcohol and a fatty acid. The use of both a fatty alcohol and a fatty acid ensures that the conversion from semi-solid to liquid state is reversible, which is advantageous to the stability of a pharmaceutical or cosmetic product during transport and standing. The reversible nature of the solidifying agent is not observed when a fatty alcohol or a fatty acid alone is used as the solidifying agent. Support for the claim is found on page 13, lines 3-6.

Claim 107 recites the use of an omega-3 oil or omega-6 oil as a hydrophobic solvent. Hydrophobic solvents rich in omega-3 oils or omega-6 oils provide additional therapeutic benefits to the cosmetic or pharmaceutical composition. Support for the claim is found on page 11, lines 14-16.

Reconsideration of the claims in view of the remarks that follow is respectfully requested.

II. Written Description Rejection

Claims 37, 40, 41, 43-51, 104 and 105 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the added statement "wherein the composition is free of particulate material that prevents liquefication of

the carrier upon application of shear force" is not described in the specification and is considered new matter. New claims 106-122 do not include the objectionable statement and the rejection may be withdrawn.

III. Rejection over U.S. Patent No. 6,224,888 to Vatter et al.

Claims 37, 40, 41, 43-51, 104 and 105 are rejected under 35 U.S.C. § 102(e) as being unpatentable to United States Patent No. 6,224,888 to Vatter et al. ("Vatter"). Applicants respectfully traverse the rejection as it applied to the currently pending claims.

The Office Action suggests that Vatter teaches the claimed invention because Vatter discloses a cosmetic composition including emollient oils (col. 5, l. 22- col. 6, l. 61) and a solidifying agent to physically and/or chemically alter a liquid base material so as to form a solid or semi-solid at ambient temperature (col. 8, 16-20).

Applicants submit that Vatter does not teach a composition that is *semi-solid* at room temperature and contains hydrophobic solvent and a solidifying agent "*consist[ing] essentially* of a long chain fatty alcohol having at least 15 carbon atoms in its carbon backbone and a fatty acid having at least 18 carbons in its carbon backbone," as is recited in independent claim 106.

Applicants further submit that Vatter does not teach a composition that is *semi-solid* at room temperature and contains a hydrophobic solvent including both "an *omega-3 or omega-6 oil* and a solidifying agent "selected from the group consisting essentially of long chain fatty alcohols having at least 15 carbon atoms in its carbon backbone and fatty acids having at least 18 carbons in its carbon backbone," as is recited in independent claim 107.

Applicants have previously argued that Vatter does not teach or suggest a composition including hydrophobic solvents and solidifying agents in the claimed proportions, which is a semi-solid at room temperature and liquefies under application of shear forces (see communications dated October 16, 2002 and April 17, 2003). Applicants maintain those arguments and provide the following additional arguments and evidence, particularly in view of the newly submitted claims.

The Office Action suggests that Vatter inherently discloses a composition that is a "semi-solid at rest and liquefies upon application of shear forces" because the solidifying agents of the instant invention are generically mentioned in the Vatter disclosure. As "proof" of the disclosure, the Office Action points to a definition of 'solidify' in the specification that encompasses both solid and semi-solid materials. However, a careful reading of the Vatter specification following this introductory remark makes it very clear that the solidifying agents relied upon in the Office Action to reject the claims are used by Vatter to obtain **solid** compositions.

Vatter refers to "wax cosmetic sticks of the present invention" (col. 8, l. 31) and "gel stick embodiments of this invention" (col. 9, l. 23). Gel sticks and wax sticks, as the conventional meanings of the terms suggest, are solids. As further evidence that the terms "gel stick" and "wax stick" refer to solid formulations, Applicants enclose a trade article in which cosmetic products in "stick" form are described. The products, both wax- and gel-based, are indisputably solid. See, Exhibit 1.

The Office Action notes that Vatter discloses cosmetic carriers in gel, mousse, foam or ointment form (col. 12, l. 10-13). However, Vatter does not teach or suggest that such carriers include a "solidifying agent comprising a combination of a long chain fatty alcohol having at least 15 carbon atoms in its carbon backbone and a fatty acid having at least 18 carbons in its carbon backbone," as is recited in claim 106, or "a hydrophobic solvent comprising an omega-3 or omega-6 oil," as is recited in claim 107. Furthermore, specific examples of creams (Example VIII) and emulsions (Examples XIII and XVII), which arguably are semi-solid at rest, do not disclose the claimed hydrophobic solvents and solidifying agents.

Furthermore, the solidifying agents disclosed in Vatter for the formation of solid wax stick and gel stick compositions do not teach or suggest the claimed combination of hydrophobic solvents and solidifying agents of the instant invention.

Vatter discloses gel-based solidifying agents selected for solubility in more polar solutions and typically having surfactant properties. Specifically, Vatter teaches:

> Solidifying agents useful in the gel stick embodiments of the invention are, in general, surface-active compounds which from networks immobilizing or solidifying the liquid base materials into a gel. Such solidifying agents include: *soaps, such as the sodium and potassium salts of higher fatty acids, i.e., acids having from 12 to 22 carbon atoms*; higher acid (*sic)* fatty acid amides of alkylolamines; dibenzaldehyde-monsorbitol acetals; alkali metal and alkaline earth metal salts of the (*sic*) acetates, propionates and lactates; waxes, such as candelilla and carnauba waxes; and mixtures thereof (emphasis added). Col. 9, l. 29-39.

The Examiner has suggested that *soaps, such as the sodium and potassium salts of higher*

fatty acids, i.e., acids having from 12 to 22 carbon atoms teach or suggest the claimed fatty acid solidifying agents. Applicants respectfully submit that the salt of a fatty acid is not a teaching (or a suggestion) of a fatty acid. Nor would one of ordinary skill in the art be inclined to substitute one for the other, precisely because of their different properties in solution. Lastly, there is no teaching or suggestion of a solidifying agent "consisting essentially of" a fatty alcohol and a fatty acid, as recited in claim 106.

Turning now to the "wax" embodiments of Vatter, Vatter discloses the use of from about 5 to about 50% of high melting point waxes (col. 8, l. 32-33), such as beeswax (col. 8, l. 38). Waxes are multi-component compositions including wax esters as major components, *i.e.* esters of long-chain fatty alcohols with long-chain fatty acids. Other constituents can vary greatly with the source of the waxy material, but they include hydrocarbons, sterol esters, aliphatic aldehydes, alcohols and ketones, *beta*-diketones, triacylglycerols, and many more.[1] Waxes therefore contain a significant amount of materials other than fatty alcohols and fatty acids and, thus, do not teach or suggest a solidifying agent that consists essentially of a fatty alcohol and a fatty acid, as defined in the present invention.

Vatter further provides specific embodiments containing about 10% to about 35% of a low melting wax, including fatty alcohols, fatty acids, and fatty acids esters and fatty acid amide,

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1 The McGraw-Hill Dictionary of Scientific and Technical Terms, 5th Ed. 1994) defines "wax" as "any of a group of substances resembling beeswax in appearance and character, and in general distinguished by their composition of

and mixtures thereof (e.g., col. 8, l. 31 *et seq.*). There is no teaching of a solidifying agent comprising a combination of a fatty alcohol and a fatty acid, nor is there any teaching or suggestion that such a combination at amounts effective to solidify the compositions to form a semi-solid at rest, as is set forth in the claims.

The use of a fatty alcohol and a fatty acid, in combination, results in a solidified carrier composition with desirable rheological properties. In addition, as noted above in Section I., the claimed carrier surprisingly exhibits reversible thinning under shear so that the composition resolidifies upon cessation of shear stress, unlike a composition comprising either a fatty acid alone or a fatty alcohol alone as solidifying agent, which liquefies irreversibly.

In conclusion, Vatter does not disclose the use of the recited solidifying agents and hydrophobic solvents of claims 106 and 107 to provide a composition that is a semi-solid at room temperature. For the foregoing reasons, the claims are patentable over Vatter and it is respectfully requested that the rejection be withdrawn

VI. Rejection over U. S. Patent 5,817,322 to Xu

Claims 37, 40-41, 43-51, 104 and 105 stand rejected under 35 U.S.C. § 102(e) as being unpatentable to United States Patent No. 5,817,322 to Xu ("Xu") Applicants respectfully traverse the rejection as it applied to the currently pending claims.

The Office Action asserts that Xu discloses a pharmaceutical base containing 5 to 25% by

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esters and higher alcohols, and by their absence of fatty acids."

weight beeswax and 95 to 75% hydrophobic solvent. Xu describes the content of beeswax as follows.

The constituents of beeswax can be grouped into four categories, i.e., esters, free acids, free alcohols and paraffins. Beeswax also contains trace amount of essential oil and pigment. Among the esters, there are myricyl palmitate, myricyl cerotate, and myricyl hypogaeate. In free acids, there are cerotic acid, lignoceric acid, montanic acid, melissic acid, psyllic acid, hypogaeic acid and neocerotic acid. Among free alcohols, there are n-octacosanol and myricyl alcohol and in the paraffins, pentacosane, heptacosane, nonacosane and hentriacontane, and an olefin called melene. An aromatic substance called cerolein is also found in beeswax."

(Col. 1, l. 53-64).

Xu does not teach or suggest the use of the recited solidifying agents and hydrophobic solvents of claims 106 and 107 to provide a composition that is a semi-solid at room temperature. For the foregoing reasons, the claims are patentable over Xu and it is respectfully requested that the rejection be withdrawn

VII. Conclusion

All currently pending claims are believed to be in conditions of allowance in light of the foregoing amendments and remarks, and an early notice thereof is respectfully solicited.

In addition, enclosed herewith please find a copy of the Petition for Three-Month extension of time with instructions to charge the required fee to Deposit Account No. 08-0219.

Applicants submit that no further fee is required. However, if further extensions or fees are required, this paper should be considered a constructive petition for any such extension and authorization to charge the required fee to Deposit Account No. 08-0219.

Respectfully submitted,

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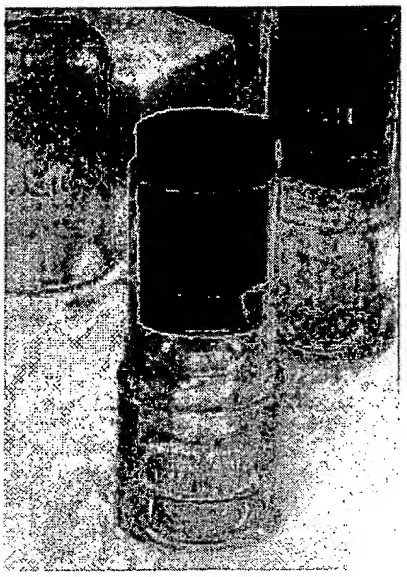
Exhibit 1

COSMETIC/ PERSONAL CARE cpc PACKAGING ON-LINE

Inside Design: Spotlight on Sticks

Details can make a simple stick stand out.

By Jennifer Kwok, Managing Editor



Transparent plastic shows off the shade of Lulu Beauty's Crème Rouge stick.

Thirty years ago, a stick was considered a novel package for foundation, blush, and eye shadow. Today, however, stick products are typical in many cosmetic lines.

"Sticks for facial cosmetics have been common for at least 50 years, if not longer," says Julio Russ, senior vice president of global color cosmetics for Revlon's R&D headquarters in New Jersey. "Revlon introduced the first blush stick, Face Gleamer, about 40 years ago."

Sticks have stuck around mainly because of their convenience. "Women want fuss-free products to accommodate today's hectic lifestyles," says Lisa Lupinski, director of global marketing for Stila Cosmetics (New York City). "Stick packaging will always be relevant because it is just simple to use."

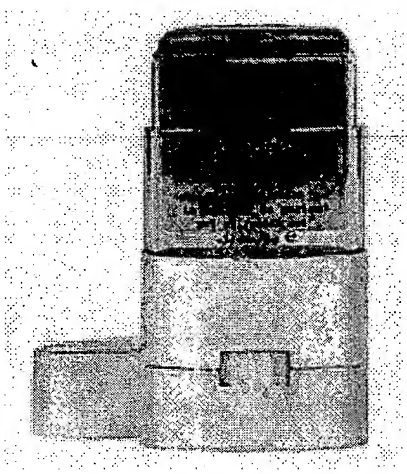
Sticks and their streamlined shapes haven't changed much over the years. However, through decoration, a product's color, and other details, companies can make their packages stick out.

Showing Your Colors

Clear sticks put a product's color at the center of attention. Also practical, transparent sticks make it easy to identify a product's shade.

Lulu Beauty's Crème Rouge stick is transparent, including its dial-style base. Customers can view the rouge's color, as well as the base's mechanisms working as the product is elevated.

Julie Merriman, founder of Lulu Beauty (Seattle), says that she wanted the Crème Rouge stick and the rest of the line to reflect 1930s fashions. One of the big trends of that decade, she says, was using clear acrylic resin for various applications. "I love the 1930s art deco look of clear Lucite, which was used for tables, lamps, and chairs," says Merriman. "I wanted a package that reflected that look."



Stila's redesigned Color Push-Ups stick features silver components for a more elegant look.

The stock plastic stick was supplied by Cosmetica Laboratories Inc. (Toronto, ON, Canada), which also formulated the Crème Rouge product. Though cosmetic stick packages weren't in fashion in the 1930s, Merriman says she felt the Crème Rouge stick would be easy for modern women to use. "Crème rouge in a pot always gets dusty and is very unsanitary," she says.

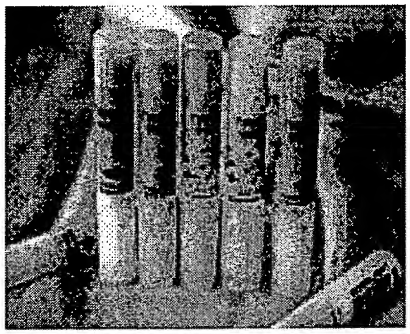
Stila Cosmetics has also chosen clear finishes for its blush sticks. This June, the brand introduced its redesigned Color Push-Ups stick, which was originally launched in 2000 as part of Stila's Sport line in a frosted oval stick. The new Color Push-Ups stick, supplied by World Wide Packaging Inc. (Florham Park, NJ), has a clear plastic middle decorated with silver hot-stamping and UV coating.

"The new sticks have the same silhouette [as the Sport stick]," says Lupinski. "The stick's base and cap are now sprayed in sleek, modern silver. The package is also now clear in the middle, so that the shades can be easily seen, making this great package even more convenient."

The upscale Color Push-Ups stick is meant to match Stila's original packages. Though Color Push-Ups has an elegant new look, the stick offers customers the same convenience as its original version.

Sheer Style

Opaque white sticks that allow a product's color to be seen are also popular.



Pinkie Swear markets its opaque plastic Glisten to Me sticks to teens, tweens, and adults. The pocket-sized sticks are convenient to carry and easy to use.

Shu Uemura's Luminizer highlighter stick is translucent white, a look that complements both brand and product image.

"Translucency is part of the Shu Uemura philosophy, which is that every product in the brand is designed not only for consumer usage, but also to be makeup artist friendly," says Michelle Kwok, marketing manager for Shu Uemura (New York City). "A package that is white and translucent allows a makeup artist to immediately identify the product shade in his or her makeup box."

The Luminizer stick was originally launched in a black PET package, but was later switched to opaque white so that the product's pearly color is visible through the package. In addition, "the color white complements the product's summer positioning, when makeup is usually lighter in color and sheer in texture," says Kwok.

Pinkie Swear (New York City) is also finding success with opaque white sticks. The brand's Eye Swear and Glisten to Me sticks, launched last winter, are slim, pocket sized, and easy for teens, tweens, and adults to use. "It's almost like a crayon," says Stephen Robinson, the company's cofounder. "It's very easy for young girls to use because it doesn't require any applicators or brushes."

Sourced from stock, the minimalist stick's most decorative feature, apart from the Pinkie Swear logo, is its opaque white plastic. This makes it easy for Pinkie Swear to save on decorating costs and to pass those savings on to its customers.

Candy Colors

Tinting a stick in juicy colors is another way to add instant appeal.

Tarte Cosmetics' (New York City) founder, Maureen Kelly, chose a stick for her brand's Cheek Stain gel because it matched Tarte's philosophy. "Tarte is all about no-frills, travel-friendly, goof-proof makeup," she says.

The look of Tarte's jam-colored Cheek Stain sticks has been compared to Jolly Rancher candies. Lombardi Design & Manufacturing custom colormatched the sticks' plastic to each Cheek Stain shade.

Kelly says that she wanted the stick's look to match the consistency of the fruity-scented gel. "I wanted the package to look translucent and sheer, like the product itself," says Kelly. She describes the colorfully tinted Cheek Stain stick as looking like a giant Jolly Rancher candy.

Prior to production, Tarte provided samples of each product shade so that supplier Lombardi Design & Manufacturing (Freeport, NY) could color-match each stick's plastic as closely as possible to each of the products. Lombardi then tinted the stick that Tarte chose, Lombardi's stock 8100 series bottom-filled push-up stick. "The colorant is added to the plastic resin itself," says Jack Albanese, sales engineer for Lombardi.

Lombardi also sprayed the stick's screw-on cap with Tarte's signature color, a metallic light-purple finish. To increase the cap's scratch resistance, UV ink was applied. The Tarte graphics were silk-screened onto the stick's body.

Since launching in 2000, Cheek Stain has become Tarte's flagship product. This fall, the company will debut another shade of Cheek Stain and the first minisized Cheek Stain sticks. A set of ministicks will be launched this holiday season.

Packaging suppliers like Rexam Makeup (Purchase, NY) are now offering similar mini, stock plastic sticks, as well as standard plastic and metal sticks in airtight and nonairtight designs.

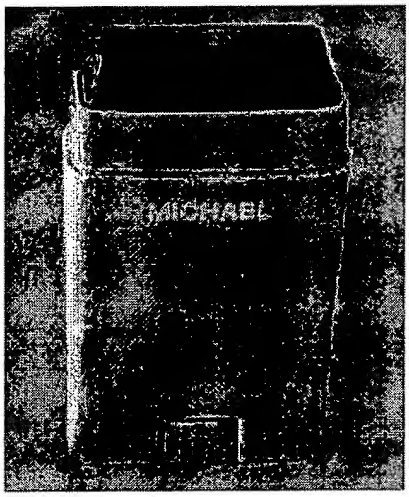
For companies looking for colorful sticks that aren't translucent, packaging

supplier DieterBakicEnterprises (Munich) offers a stock dial-style SAN stick which, like most DieterBakic packages, matches the look of the brand's other components. The Dave stick is available with top or bottom filling and can hold 8 ml of blush, foundation, or sunscreen.

Future Trends

Some packaging suppliers predict that what will get customers' attention most is not only how a stick is decorated, but what's inside the stick.

Michel Limongi, creative director for Techpack's Innovation Center in Paris, mentions two stick package concepts that Techpack is developing. The first is a larger package which holds three sticks for solid or creamy skincare products. "A package that can hold a stick of makeup remover, face scrub, and moisturizer would be very convenient for women to use when they are traveling, instead of carrying separate bottles, jars, and tubes," says Limongi.



Michael Kors' Leg Shine package features the same stick model used for the brand's men's deodorant. The wide stick is well suited for gliding on a woman's leg.

The second trend that Limongi predicts is using large-diameter sticks for body-care products like sunscreens and lotions.

The Michael Kors Leg Shine stick, launched last year, is a good example. The solid-gel stick has pearlescent and metallic pigments to add shine to a woman's leg.

The 2.7-oz polypropylene stock stick, supplied by VPI (Orgelet, France), is the same model that holds Michael Kors men's deodorant. "The reason for packaging the Leg Shine in the deodorant stick was to bring innovation to the product category and to utilize existing stock packaging," says Tom Butkiewicz, former director of operations for LVMH Perfumes and Cosmetics (New York City). "Since this was the same stick used for the Michael Kors deodorant, we knew that the stick felt ergonomic and we thought that it would lend itself well to use on a woman's leg."

American Designer Fragrances, a division of LVMH, owned the Michael Kors Fragrances license until Estée Lauder acquired it this March. Butkiewicz now serves as vice president of operations and product development for Zirh, a division of Shiseido.

Unlike the men's deodorant stick, which is black, the Leg Shine stick and its cap were sprayed with a soft-touch camel-colored finish to give them upscale appeal. The white logo was silk-screened on the stick.

"To our knowledge, we have not seen competitive products used in a deodorant-style container," says Butkiewicz. "The innovation the package has brought in

regards to product application--a gliding effect--has been well received by the consumer. In the field, we are commonly being asked for other moisturizing formulas to be offered in a similar-style package."

Sticking Around

Though sticks were once offered as trendy alternatives to more classic packages like compacts, as Vanessa Gerold, marketing manager for Rexam Makeup, points out, "In the packaging industry, the stick has become its own category."

With the large number of sticks now in the market, the ones that make an impression on customers, either by decoration or by the products they hold, remain competitive. "Sticks are still a big business," says Revlon's Russ. "I think they'll always be around."